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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/822,049

04/10/2004

Ronald John Rosenberger

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09/08/2006

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EXAMINER

MAKI, STEVEN D

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/822,049	Applicant(s) ROSENBERGER, RONALD JOHN	
	Examiner Steven D. Maki	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10,12,13,16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10,12,13,16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1733

- 1) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2) Claims 6-9 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, the description of "said void, insert, o-ring or plug comprises ... and/or a groove, channel or crevice" is confusing. It appears that only the void comprises a groove, channel or crevice". It appears that an o-ring comprising a groove provided in at least one void is not intended. In claim 6, it is suggested to change "and/or a groove, channel, or crevice" to --and said void comprises--.

- 3) Claims 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 10 (dependent on claim 1) describes the plug, o-ring or insert as being a. or b. or c. or d. Since claim 10 fails to require selection of c. (the ability of the plug, o-ring or insert being removable), it broadens claim 1 which requires "at least one removable insert, o-ring or plug".

- 4) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 1733

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Great Britain 584

6) **Claims 1, 4-10, 12-13 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Great Britain 584 (GB 2,243,584).**

Great Britain 584 discloses a vehicle tire having grooves 21 and wear indicators 10 wherein the wear indicator 10 is a rubber, grommet, block or stud made from three layers of different colored rubber or alternatively two angled wedges. The wear indicator 10 is pushed into the groove such that the outer surface of the wear indicator is flush with the outer surface of the tread. The wear indicator 10 is held in the place by elasticity of the walls of the groove 21. See page 3.

As to claim 1, the claimed tire is anticipated by Great Britain 584's vehicle tire. The claimed removable insert, ring or plug reads on the wear indicator 10. This wear indicator is "removable" since it is held in the groove (void) merely by the elasticity of the walls of the groove. With respect to the insert, o-ring or insert comprising at least one scent or fragrance, Great Britain 584's rubber wear indicator, like all rubber, inherently has a "scent". It is noted that terms such as "novelty", "unique aroma" and "salient, distinctive, and marketable feature of said vehicle tire" were deleted from claim

Art Unit: 1733

1. Furthermore, Great Britain 584's rubber wear indicator wears at the same rate as the tread (page 2) such that lower regions of rubber, which also inherently have a "scent", are exposed.

As to claims 4 and 13 (wear warning component), note Great Britain 584's use of plural wear indicators.

As to claim 5 (color), Great Britain 584's wear indicator comprises different colored rubber layers. In view of the opposite terms "coordinated" and "incongruous", claim 5 fails to define a color different from that suggested by Great Britain 584.

As to claims 6 and 7 (void), Great Britain 584 locates the wear indicators 10 in grooves.

As to claim 8, Great Britain 584 discloses a car tire (page 3).

As to claim 9, Great Britain 584 shows two wear indicators 10 in the same groove
21. See figure 3.

As to claim 10 (removable), Great Britain 584's wear indicator is removable from the void since it is held in the groove merely by the elasticity of the groove.

As to claim 12 (e.g. reflective, fluorescent), Great Britain 584 teaches including reflective particles in the layers of the wear indicator or making the middle layer fluorescent.

As to claim 16 (wear indicator formed by pouring, pumping, injecting or spraying), this product by process claim fails to require structure different from the rubber wear indicator disclosed by Great Britain 584. See MPEP 2113.

As to claim 17, Great Britain 584's wear indicator comprises at least two "sections" such as three layers.

7) Claims 1, 4-10, 12-13 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain 584 in view of Korea (2004029611), Japan 873 (JP 2002-114873) or German 356 (DE 2949356).

Korea (published 4-8-04 as evidenced by the Derwent abstract) is available as prior art since applicant is not entitled to the benefit of the filing date 4-17-03 of applicant's provisional application. See MPEP 201.11. None of the pending claims is directed solely to the subject matter disclosed in the provisional application. For example, the provisional application does not support "at least one removable insert, o-ring or plug provided in at least one void contained adjacent to the outside surface of at least one of a tread, a belt or a ply of said vehicle tire". Hence, Korea is available as prior art under 35 USC 102(a) because (1) its publication date (4-8-04) is before applicant's filing date (4-10-04) and (2) claims 1-2, 4-10, 12-13 and 16-17 are not entitled to the benefit of the filing date of applicant's provisional application 60/463,653. Claim 1 describes subject matter (e.g. removable insert, o-ring, or plug) not described in the provisional application.

Great Britain 584 is considered to anticipate claim 1. In any event: it would have been obvious to one of ordinary skill in the art to provide Great Britain 584's rubber wear indicator, which is part of the tread, such that it comprises a "scent" in view of one of Korea, Japan 873 and German 356 wherein Korea (directed to the tire art) teaches using a composition comprising rubber and aromatic material such that smell is

Art Unit: 1733

generated from the tread when the tread reaches the wear limit, Japan 873 (directed to the tire art) suggests including perfume sealed particles in a tread composition such that perfume is released by wear of the tread so as to emit a desired aroma for a long time, and German 356 (directed to a wear monitor) suggests providing a wear monitor in a lining such that the indicator emits a smell when the lining has worn (abstract)

Japan 873

8) Claims 1, 5-10 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 873 (JP 2002-114873) in view of French 013 (FR 2800013), Canada 958 (CA 547,958) or Japan 908 (JP 11-151908).

Japan 873 discloses a pneumatic tire for a passenger car having a size such as 185/65R14. The tread of this tire comprises particles containing perfume. Japan 873 teaches that the perfume containing particles are exposed with tread wear and that the aroma is emitted for a long time. See abstract and machine translation of Japan 2002-114873. Japan 873 does not recite the tire as having a removable insert.

As to claim 1, it would have been obvious to one of ordinary skill in the art to provide Japan 873's tire with a removable insert in a void such that the insert, which is part of the tread, comprises a "scent" which is released as the tire wears in view of (1) Japan 873's teaching to include perfume containing particles in a tread such that the perfume containing particles are exposed with tread wear and that the aroma is emitted for a long time and (2) the suggestion from French 013, Canada 958 or Japan 908 to provide a tire with an insert wherein French 013 teaches providing a removable colored auxiliary tire 20 ("removable insert") in a trough 11 of an outer annular tread such that

Art Unit: 1733

the auxiliary tire 20 can be replaced with a different color, Canada 958 teaches providing a tire with a removable tire component 7 ("removable insert") in a recess 4 so that the tread can be replaced when worn and thereby avoid the cost of replacing the entire tire and Japan 908 teaches providing a tire with colored member 6 ("removable inserts") in a groove of a tire tread to improve the fashionableness of the tire. The term "insert" is generic to "o-ring". With respect to Japan 908's insert being removable, see paragraphs 13, 14 and 35 of Japan 908. In particular, Japan 908 teaches locating colored members 6 in grooves of a tire tread (either by inserting premanufactured rings in the grooves or pouring colored material in the grooves) to improve the fashionableness of the tire (abstract, machine translation). It is noted that (1) "removable" is a relative term, (2) claim 16 recites an insert formed by pouring and (3) page 18 of the specification teaches that the insert may be removed by using a drill or a dremel tool (cutting / grinding tool). Hence, one of ordinary skill in the art would have been motivated to include perfume containing particles in the removable insert of French 013, Canada 958 or Japan 908 so as to obtain the expected benefits of (1) a tread which can emit desired aroma as the tire wears and (2) having part of the tread being removable to change color of the tread (French 013), having part of the tread replaceable to avoid the cost of replacing the entire tread (Canada 958) or improving the fashionableness of the tire (Japan 908). It is emphasized that each of the "removable inserts" of French 013, Canada 958 and Japan 908 constitute part of the tread and Japan 873 suggests including perfume containing particles in the entire tire tread (all parts of the tread).

Art Unit: 1733

As to claim 5, French 013 and Japan 908 teach a colored insert. Also, the insert of Canada 958 must have a color (i.e. black).

As to claim 6 (void), French 013 teaches a trough 11, Canada 958 teaches a recess 4 and Japan 908 teaches a groove 7.

As to claims 7, 9, 16 and 17, Japan 908 teaches using plural colored members 6 two or more kinds of colors.

As to claim 8 (tire), note the type of tire suggests by the applied prior art. For example, Japan 873 teaches a car tire.

As to claim 10 (removable), French 013, Canada 958 and Japan 908's "insert" is "removable".

9) Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 873 in view of French 013, Canada 958 or Japan 908 as applied above and further in view of Berliner (US 5278141).

As to claim 2, it would have been obvious to one of ordinary skill in the art to use both a perfume and a pheromone as the perfume in the tire of Japan 873 since Berliner suggests (1) using both perfumery odorant and a pheromone in a perfume to make the perfume more appealing and (2) using perfume in a variety of products (col. 7 lines 30-52).

10) Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 873 in view of French 013, Canada 958 or Japan 908 as applied above and further in view of French 340 (FR 1498340).

Art Unit: 1733

As to claims 4 and 13, it would have been obvious to one of ordinary skill in the art to provide the perfume containing particle tire tread with the claimed wear warning component since French 340 suggests locating a colored indicator (e.g. colored rubber or tearable cell containing coloring agents) in the groove of a tire to achieve visual monitoring of the degree of wear of the tire (see translation).

11) **Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 873 in view of French 013, Canada 958 or Japan 908 as applied above and further in view of Mellet et al (WO 01/43958).**

As to claim 12, it would have been obvious to one of ordinary skill in the art to use reflective particles in the rubber tread insert since (1) French 013 or Japan 908 teach using a colored insert for a tire tread and (2) Mellet et al teaches providing a cover for a tire with color and reflective particles (page 6).

Remarks

12) Applicant's arguments with respect to claims 1-2, 4-10, 12-13 and 16-17 have been considered but are moot in view of the new ground(s) of rejection; it being noted that original claim 6 did not require the plug or insert to comprise scent or fragrance. See claim 7, which was dependent on claim 6.

13) No claim is allowed.

14) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1733

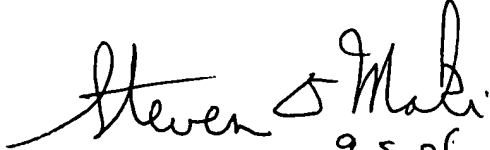
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven D. Maki
September 5, 2006


STEVEN D. MAKI
PRIMARY EXAMINER
9-5-06